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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CARL E. WHITCOMB

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Appeal 2008-2136  
Application 10/770,352  
Technology Center 3600

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Decided: June 13, 2008

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Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-40 and 46-50. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM-IN-PART and make a NEW GROUND OF REJECTION.

Appellant claims a sidewall 17 for a plant container 10 comprising a substantially water-impermeable root-tip-trapping region 13 and a porous air-root-pruning region 20 adjacent the root-tip-trapping region (claim 1; figs. 1, 2, 6). Appellant also claims a sidewall 17 for a plant container 10 comprising a water permeable, porous fabric layer 18 and a water impermeable, root-impenetrable layer 16 bonded to a portion of the outer face of the fabric layer (claim 46; fig. 2).

Representative independent claims 1 and 46 read as follows:

1. A sidewall for a plant container, comprising:

a substantially water-impermeable root-tip-trapping region; and

a porous air-root-pruning region adjacent the root-tip-trapping region.

46. A sidewall for a plant container, comprising:

a water permeable, porous fabric layer and a water impermeable, root-impenetrable layer bonded to a portion of the outer face of the fabric layer.

The prior art set forth below is relied upon by the Examiner as evidence of unpatentability:

Reynolds	3,080,680	Mar. 12, 1963
Thomas	5,311,700	May 17, 1994
Flasch, Jr.	5,852,896	Dec. 29, 1998
Reiger	6,202,348 B1	Mar. 20, 2001
Lai	6,505,440 B1	Jan. 14, 2003
Berlit	GB 2,073,567 A	Oct. 21, 1981
Van der Goorbergh	EP 0 300 578	Jan. 15, 1989

The following rejections are before us in this appeal.<sup>1</sup>

Claims 1-4, 7, 11, 12, 20, 26, 27, 37-40, and 46 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Reynolds.

Under 35 U.S.C. § 103(a):

claims 5, 6, 8, 9, 14-16, 24, 32, 33, and 36 are rejected as being unpatentable over Reynolds;

claims 10, 13, 17-19, and 47-50 are rejected as being unpatentable over Reynolds in view of Reiger;

claim 21 is rejected as being unpatentable over Reynolds in view of Thomas;

claims 22 and 23 are rejected as being unpatentable over Reynolds in view of Berlit;

claims 25, 29, and 31 are rejected as being unpatentable over Reynolds in view of Van der Goorbergh;

claims 28, 34, and 35 are rejected as being unpatentable over Reynolds in view of Flasch; and

claim 30 is rejected as being unpatentable over Reynolds in view of Berlit and further in view of Flasch.

#### *OPINION*

For the reasons expressed below, we reverse the rejections of claims 1-40 and affirm the rejections of claims 46-50.

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<sup>1</sup> The new ground of rejection under the first paragraph of 35 U.S.C. § 112 made by the Examiner in the Answer has been withdrawn in the communication mailed October 30, 2007.

*The rejections of claims 1-40*

Concerning the § 102 rejection of independent claim 1, the Examiner considers the fibrous walls of pot 18 in combination with the polymer sheet 60, 62 of Reynolds to satisfy the claimed root-tip-trapping region and the perforated bottom of sheet 60, 61 to satisfy the claimed porous air-root-pruning region (Final Office Action 2). The Examiner acknowledges that Reynolds teaches roots will grow through pot 18 and into the space between the pot and the polymer sheet 60, 62 (Ans. 5-6) but finds that "the space between sheet 60 and pot 18 is a root tip trapping region because the roots cannot escape through the sheet 60 since it is root impenetrable as taught by Reynolds" (Ans. 6). The Examiner also acknowledges that it is the perforated bottom of Reynolds' container which is considered to satisfy the air-root-pruning region of the claimed sidewall but finds that the bottom of a pot would be regarded in this art as a bottom sidewall (Ans. 6).

Appellant argues that, when properly construed, claim 1 is not anticipated by Reynolds (App. Br. 6-11, Reply Br. 8). Specifically, Appellant argues that the "root-tip-trapping" function of claim 1 "means that the tip of a root becomes trapped and cannot grow or extend any further" (App. Br. 6). Because roots indisputably continue growing in the interface between the polymer sheet and pot of Reynolds, it is Appellant's contention that "Reynolds does not disclose any structure that possesses the claimed characteristic of a root-tip-trapping region" (App. Br. 9). Appellant also argues that the Specification consistently distinguishes between the claimed "sidewall" and a "bottom" of a plant container (App. Br. 7) and accordingly that Reynolds' perforated bottom does not satisfy the claim 1 requirement for

a sidewall comprising an air-root-pruning region (App. Br. 8-9). These arguments are persuasive.

As correctly pointed out by Appellant (App. Br. 4-5), during examination, claims should be given their broadest reasonable interpretation consistent with the Specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). When so construed, the claim 1 requirements for a "root-tip-trapping region" and an "air-root-pruning region" are not satisfied by Reynolds.

As indicated above, the Examiner interprets the claim 1 "root-tip-trapping region" as encompassing the polymer sheet and fibrous pot sidewall of Reynolds even though patentee expressly teaches that roots grow into the interface between the sheet and pot (Ans. 5-6). However, this interpretation is inconsistent with Appellant's Specification which teaches that the root-tip-trapping region traps the root tip so as to stop further root extension and thereby prevent the root tips from growing and circling the container perimeter in the manner disclosed by Reynolds (Spec. paras. [0009], [0029]). Also inconsistent with Appellant's Specification is the Examiner's interpretation of the sidewall air-root-pruning region required by claim 1 as encompassing the perforated bottom of Reynolds' container. Furthermore, as convincingly argued by Appellant (Reply Br. 8), this inconsistency is not somehow negated, as the Examiner believes (Ans. 6), simply because a pot bottom has been referred to in the prior art as a bottom sidewall.

In light of the foregoing, we reverse the Examiner's § 102 rejection of independent claim 1 and of claims 2-4, 7, 11, 12, 20, 26, 27, and 37-40 as being anticipated by Reynolds. The remaining claims which depend from

claim 1 are rejected under § 103 based on modifications proposed by the Examiner which do not cure the above discussed deficiencies of Reynolds. Therefore, we also reverse the § 103 rejections of these remaining dependent claims based on Reynolds alone or further in view of the Reiger, Thomas, Berlitz, Van der Goorbergh, and Flasch references.

In summary, we have reversed the Examiner's rejections of claims 1-40.

*The rejections of claims 46-50*

Independent claim 46 is rejected under § 102(b) as being anticipated by Reynolds. In the sections of the Appeal and Reply Briefs which present arguments against the Examiner's § 102 rejection, Appellant does not specifically identify and address claim 46. Nevertheless, it appears that Appellant believes that Reynolds' porous fabric layer (i.e., pot 18) and root-impenetrable layer (i.e., polymer sheet 60, 62) are not bonded to one another as required by claim 46 (App. Br. 16, Reply Br. 7). Such a belief is not well taken.

Reynolds expressly teaches that the polymer sheet (or plastic film) may be applied in liquid form and cured (col. 2, ll. 47-52) and that the sidewall portions 62 of the polymer sheet are adherent to the sidewalls 16 of the pot (col. 6, ll. 3-6). These teachings reasonably support the determination that patentee's pot (i.e., the claimed porous fabric layer) and polymer sheet (i.e., the claimed root-impenetrable layer) are bonded together as required by the claim under review.

For this reason, we sustain the § 102 rejection of claim 46 as being anticipated by Reynolds.

Concerning the § 103 rejection of claims 47-50 (which depend from claim 46) as being unpatentable over Reynolds in view of Reiger, Appellant presents no argument which specifically identifies these claims. Instead, the rejection based on Reynolds in view of Reiger is generally asserted to be improper because "Appellant finds no ... motivation or suggestion to combine these references" (App. Br. 16). However, the Examiner has proffered multiple reasons why an artisan would have combined these references in such a manner as to satisfy the requirements of the claims under review (Final Office Action 6-7). Because Appellant has failed to identify any error in the Examiner's proffered reasoning, we are unpersuaded by the general assertion that no motivation or suggestion exists for combining Reynolds and Reiger.

It follows that we also sustain the Examiner's § 103 rejection of claims 47-50 as being unpatentable over Reynolds in view of Reiger.

#### *THE NEW GROUND OF REJECTION*

Our foregoing review of the Examiner's rejections has led us to determine that claim 1 is unpatentable over the applied prior art reference to Reiger. Therefore, we make the following new ground of rejection of claim 1 pursuant to our authority under 37 C.F.R. § 41.50(b).<sup>2</sup>

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<sup>2</sup> We emphasize that our patentability analysis for this new ground of rejection based on Reiger is limited to independent claim 1 only. We have not analyzed whether any of the claims which depend from claim 1 are unpatentable based on Reiger alone or further in view of additional prior art.



Claim 1 is rejected under 35 U.S.C. § 102(a) as being anticipated by Reiger.

Reiger discloses a plant container comprising a plastic pot 115 having a sidewall 142 including a fabric liner 120 which traps root tips 184 in such a way as to stop the apical growth of roots and to prevent root circling (Figs. 8, 9, 12; col. 7, ll. 42-62, col. 8, ll. 28-49).

Patentee's plastic sidewall 142 and fabric liner 120 define a region which is water-impermeable and which performs a root-tip-trapping function. It follows that Reiger's plastic sidewall and fabric liner combination fully satisfies the claim 1 requirement for "a substantially water-impermeable root-tip-trapping region."

Reiger's plastic sidewall 142 also includes a plurality of drain holes 146 (Fig. 8; col. 7, ll. 52-54). Because the fabric liner 120 adjacent these drain holes is exposed to air, we determine that this adjacent fabric liner inherently performs the air-root-pruning function recited in claim 1. *See In re Cruciferous Spout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (A prior art reference may anticipate when the claim limitations not expressly found in the reference are nonetheless inherent in it).

Our determination is reasonable since Reiger expressly teaches that root tips are capable of penetrating the fabric liner and thereupon stop growing when directed into the sidewall 142 of pot 115 (col. 8, ll. 38-48). Because no sidewall 142 exists at the regions defined by drain holes 146, the afore-noted roots which penetrate the fabric liner in those drain hole regions would be necessarily exposed to air and pruned thereby in the same way as roots are air pruned in Appellant's claimed air-root-pruning region. *See Ex*

*parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990) (inherency must be reasonably supported by a basis in fact and/or technical reasoning).

Under these circumstances, Reiger's fabric liner regions adjacent drain holes 146 satisfy the claim 1 requirement for "a porous air-root-pruning region adjacent the root-tip-trapping region."

### CONCLUSION

We have reversed the Examiner's rejections of claims 1-40.

We have affirmed the Examiner's rejections of claims 46-50.

We have made a new ground of rejection against claim 1.

In addition to affirming the Examiner's rejection(s) of one or more claims, this opinion contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

The decision of the Examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED-IN-PART**

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